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10/006,874	11/14/2001	Michael A. Plomick	T738-10	5480

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2616

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/006,874

Applicant(s)

PLOTNICK ET AL.

Examiner

HUY T. NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-109 is/are pending in the application.
- 4a) Of the above claim(s) 70-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 37-62, 69 and 99-109 is/are rejected.
- 7) ☒ Claim(s) 28, 33-36 and 63-68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/23/04, 7/26/04, 7/30/04, 9/24/03, 7/18/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-68 and 99-109 in the reply filed on 13 December 2004 is acknowledged.

Claims 70-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 20-27, 29-31, 37-62, 69, 99 -100 and 102-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Unger (6,909,837).

Regarding claims 1, 55. Unger discloses a method for displaying an alternative advertisement to a subscriber during a trick-play event, the method comprising:  
detecting the trick-play event during playback of a recorded advertisement; and

displaying the alternative advertisement to the subscriber (Fig. 1-4, column 2, lines 45-60).

Regarding claim 2, Unger further teaches the method of claim 1, wherein said displaying includes displaying the alternative advertisement instead of the recorded advertisement (column 2, lines 45-60).

Regarding claim 20, Unger further teaches , wherein said detecting includes detecting an initiation of the trick play event (fast forward) during playback of the recorded advertisement (column 7, lines 1-23).

Regarding claim 21, Unger further teaches the method of claim 1, wherein said detecting includes detecting a start of a recorded advertisement during the trick play event (column 7, lines 1-23, Fig. 4) .

Regarding claim 22, Unger further teaches the method of claim 1, further comprising detecting an end of the recorded advertisement; and stopping the display of the alternative advertisement (column 7, lines 23-31).

Regarding claim 23, Unger further teaches the method of claim 22, further comprising displaying recorded programming in trick play mode (column 7, lines 23-31).

Regarding claim 24, Unger further teaches the method of claim 22, further comprising determining that another recorded advertisement is in trick play mode; determining that there is an associated alternative advertisement therefore; and displaying the associated alternative advertisement (column 7, lines 1-23, Fig. 4).

Regarding claim 25, Unger further teaches the method of claim 1, further comprising detecting a start of a second recorded advertisement during the trick play event; and displaying a second alternative advertisement associated with the second recorded advertisement (column 7, lines 1-23) .

Regarding claim 26, Unger further teaches the method of claim 1, further comprising detecting an end of the trick play event; stopping the display of the alternative advertisement (column 7, lines 20-31).

Regarding claim 27, Unger further teaches the method of claim 26, further comprising displaying recorded programming (column 7, lines 23-32).

Regarding claim 29, Unger further teaches the method of claim 1, further comprising determining point in recorded advertisement that the trick play event occurs (user input trick play) .

Regarding claims 30 ,31 and 32, Unger further teaches the method of claim 29, wherein said displaying includes displaying the alternative advertisement if a determination is made that the trick play event occurs within a predefined period from a start of the recorded advertisement (column 5, column 7, line 5-30, the user can set a period from the start of the recorded advertisement to input a trick play or fast forward mode for the recorded advertisement .

Regarding claim 35, Unger further teaches the method of claim 29, further comprising modifying the alternative advertisement based on said determining. (column 6, lines 1-10)

Regarding claim 37 Unger further teaches the alternative advertisement is related to the recorded advertisement (column 5, lines 40-60, column 6, line 1-10)

Regarding claim 38, Unger further teaches the method of claim 1, wherein the alternative advertisement is approximately an amount of time equal to time associated with fast forwarding through the recorded advertisement (columns 5-6) .

Regarding claim 39, Unger further teaches the method of claim 37, wherein the alternative advertisement (message) is a separately produced advertisement (column 5, lines 45-69, Fig. 4).

Regarding claim 40, Unger further teaches the method of claim 37, wherein the alternative advertisement is derived from the recorded advertisement (Fig. 4, column 6, lines 1-10 column 7, lines 1-23).

Regarding claim 41, Unger further teaches the method of claim 40, wherein the alternative advertisement is derived by applying processing rules to the recorded advertisement (column 5, lines 47-60, column 6, lines 1-10, column 7, lines 30-56).

Regarding claims 42 and 43, Unger further teaches the method of claim 41, wherein the processing rules are specific to the recorded advertisement(column 6, lines 1-10, column 7, lines 30-56)..

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Regarding claim 44, Unger further teaches the method of claim 41, wherein the processing rules are generic (column 5, lines 43-60).

Regarding claim 45, Unger further teaches the method of claim 41, wherein the alternative advertisement is a still image from the recorded advertisement (column 6, lines 1-10, column 7, lines 1-23).

Regarding claim 46, Unger further teaches the method of claim 41, wherein the alternative advertisement is a series of still images from the recorded advertisement (column 6, lines 1-10, column 7, lines 15-56).

Regarding claim 47, Unger further teaches the alternative advertisement is a video segment from the recorded advertisement (column 7, lines 15-56).

Regarding claim 48, Unger further teaches the method of claim 41, wherein the alternative advertisement is a series of video segments from the recorded advertisement (column 7, lines 15-56).

Regarding claim 49, Unger further teaches the method of claim 41, wherein the alternative advertisement is a combination of still images and video segments from the recorded advertisement (column 7, lines 15-56).

Regarding claim 50, Unger further teaches the method of claim 41, wherein the alternative advertisement is a portion of the recorded advertisement with computer generated graphics added thereto (column 5, lines 50-60).

Regarding claim 51, Unger further teaches the method of claim 1, wherein the alternative advertisement is related to more than one recorded advertisement (column 7, lines 1-23, Fig. 4).

Regarding claim 52, Unger further teaches the method of claim 51, wherein the alternative advertisement is displayed during a trick play event for the more than one recorded advertisement (column 7, lines 1-23, Fig. 4).

Regarding claim 53, Unger further teaches the method of claim 1, wherein the alternative advertisement is not related to the recorded advertisement (column 7, lines 1-23, Fig. 4).

Regarding claim 54, Unger further teaches the method of claim 1, wherein trick play events include fast forwarding, skipping, rewinding, and pausing (Abstract, column 5).

Regarding claim 56 Unger further teaches the system of claim 55, wherein said means for displaying displays the alternative advertisement instead of the fast forwarding recorded advertisement (column 5).

Regarding claim 59 Unger further teaches the system of claim 55, wherein said means for detecting detects a start of a recorded advertisement during the fast forward event (Fig. 4, column 7, lines 1-15).

Regarding claim 60, Unger further teaches the system of claim 59, wherein said means for detecting also detects an end of the fast forwarding recorded advertisement; and

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said means for displaying stops displaying the alternative advertisement at the end of the fast forwarding recorded advertisement (column 7, lines 1-30).

Regarding claim 61, Unger further teaches the system of claim 55, wherein said means for detecting detects an initiation of the fast forward event during playback of the recorded advertisement (column 5).

Regarding claim 62, Unger further teaches the system of claim 61, wherein said means for detecting also detects an end of the fast forward event; and said means for displaying stops displaying the alternative advertisement at the end of the fast forward event.

Regarding claim 99, Unger teaches a personal video recorder (PVR) (Fig. 1, column 4, lines 13-25))capable of displaying alternative ads during trick play events, the PVR comprising:

memory;(RAM)

means for detecting a trick play event during playback of an advertisement within recorded programming (columns 5,6, column 7, lines 1-23); and

means for displaying an alternative advertisement during the trick play event for the recorded advertisement (column 7, lines 1-23).

Regarding claim 100, Unger further teaches the PVR of claim 99, wherein the recorded programming is on a medium (column 4, lines 40-68).

Regarding claim 102, Unger further teaches the PVR of claim 99, further comprising: means for receiving programming; and (column 4, lines 40-68)  
means for recording the programming (column 4, lines 40-68)

Regarding claim 103, Unger further teaches the PVR of claim 99, further comprising means for receiving alternative advertisements (Fig. 4, columns 5-6)).

Regarding claim 104. Unger further teaches the PVR of claim 103, wherein the alternative advertisements are related to with the recorded programming.

Regarding claim 105, Unger further teaches the PVR of claim 103, wherein the alternative advertisements have a format similar to that of the recorded advertisements (column 6, lines 1-10).

Regarding claim 106, Unger further teaches the PVR of claim 103, wherein the alternative advertisements have a different format than the recorded advertisements (Fig. 4, column 5, lines 30-55, column 6, lines 1-10).

Regarding claim 107, Unger further teaches the PVR of claim 103, wherein the alternative advertisements may be some combination of digital video, streaming media, HTML, Flash, Shockwave and audio (column 5, lines 45-60).

Regarding claim 108, Unger further teaches the PVR of claim 103, wherein the alternative advertisements are not related to the recorded programming. (Fig. 4, column 5, lines 30-55, column 6, lines 1-10).

Regarding claim 109, Unger further teaches the PVR of claim 99, further comprising: means for receiving processing rules; and means for generating alternative advertisements by applying the processing rules to the recorded advertisements (column 4, lines 40-68, column 5, lines 45-60, column 6, lines 1-10)..

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Unger (6,909,837) in view of Official Notice .

Unger fails to teach the medium is a CD ,DVD or program server . However it is noted that using a CD or DVD for storing data is well know in the art . Therefore

Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Unger by using a CD or a DVD as an alternative to the medium of Unger for storing the program data and advertisement data .

6. Claims 3,4,7-14,17-19 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger (6,909,837) in view of Hakamada et al (4,845,564).

Regarding claims 3 and 57-58, Unger further teaches receiving the advertisement , recording the advertisement , reproduced the advertisement and displaying the received and recorded advertisement but fails to specifically teaches superimposing the alternative advertisement the recorded advertisement .

Hakamada teaches a recoding and reproducing system having a superimposing mean for superimposing an alternative video signal with a recorded signal or the received video signal with the recorded video signal (Figs. 3, column 6, lines 25-65). Further Hakamada teaches the receiving advertisement and recorded advertisement from a broadcast signal.

It would have been obvious to One of ordinary skill ion the art to modify Unger with Hakamada Inoue by providing the Unger with a superimposing means as taught by Inoue for receiving alternative advertisement and recorded advertisement and superimposing the alternate advertisement and recorded advertisement thereby enhancing the capacity of the apparatus of Unger in displaying the advertisement .

Regarding claim 4, Unger as modified with Hakamada further teaches the method of claim 3, wherein the superimposed alternative advertisement covers a portion of the recorded advertisement (Fig. 3).

Regarding claims 7,8,9 and 17 , Unger as modified with Hakamada further teaches the method of claim 3, wherein at least some subset of video features associated with the superimposed alternative advertisement are adjustable since Hakamada teaches the video signal is color signal and adjusting contrast, tint or bright an hue are features included in a color TV.

Regarding claim 10, Unger as modified with Hakamada further teaches the method of claim 3, wherein at least some subset of video features associated with the superimposed alternative advertisement are different from a corresponding subset of the video features associated with the recorded advertisement since Unger and Hakamada teaches receiving the advertisement can be superimpose to the recorded advertisement (Fig. 3)

Regarding claims 11 and 12, Unger as modified with Hakamada further teaches the method of claim 10, wherein the superimposed alternative advertisement is more distinct than the recorded advertisement or the recorded advertisement is more distinct than the superimposed alternative advertisement by selectively displaying the alternative advertisement or recorded advertisement in larger area of the display (Fig. 3) .

Regarding claim 13, 14, 18-19, Unger as modified with Hakamada further teaches said displaying includes superimposing the alternative advertisement over the recorded advertisement (Fig. 3).

7. Claims 5, 6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger in view of Hakamada et al (4,845,564) as applied to claim 1-3 and 14 above, further in view of Canfield et al (5,031,044)

Regarding claims 5, 6, 15 and 16, Unger as modified with Hakamada fails to teach the size and location of superimposed alternative advertisement or recorded advertisement are adjustable.

Canfield teaches an apparatus having control means for generating superimposed picture with a picture and the size and location of the superimposed picture is adjustable (column 1, line 30 to column 2 line 35, Figs. 2-4). It would have been obvious to one of ordinary skill in the art to modify Unger as modified with Hakamada by providing the apparatus of Unger as modified with Hakamada with a control means as taught by Canfield for receiving the recorded advertisement and superimposed advertisement as taught by Canfield to changing the size or location of the superimposed advertisement thereby enhancing the capacity of the apparatus of Unger for selecting displaying of the advertisements.

***Allowable Subject Matter***

8. Claims 28,33-36 and 63-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N.

  
HUY T. NGUYEN  
PRIMARY EXAMINER

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